

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tetsuya Noguchi et al. **Examiner:** Minh Dieu T. Nguyen
Serial No.: 09/818,802 **Art Unit:** 2437
Filed: March 27, 2001 **Docket:** JP920000026US1 (21146)
For: ELECTRONIC CONTENTS PROVING **Dated:** May 26, 2009
METHOD AND SYSTEM, AND STORAGE
MEDIUM FOR STORING PROGRAM THEREOF

Confirmation No.: 9893

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Office of Petitions

**PETITION TO WITHDRAW A HOLDING OF
ABANDONMENT FOR FAILURE TO RECEIVE OFFICE ACTION**

Sir:

This Petition to Withdraw a Holding of Abandonment and the accompanying exhibits, are submitted in response to the Notice of Abandonment dated March 26, 2009. The Petition complies with the guidelines set out in MPEP § 711.03(c)(I)(A).

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being deposited with the United States Patent & Trademark Office via Electronic Filing through the United States Patent and Trademark Office e-business website, on May 26, 2009.

Dated: May 26, 2009


Steven Fischman

Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action

The Petitioner, Steven Fishman, is a partner of the law firm of Scully, Scott, Murphy & Presser, P.C, having a correspondence address of record at 400 Garden City Plaza, Garden City, New York 11530, which is the correspondence address of record for the applicants of above-referenced application, Tetsuya Noguchi, et al. The Petitioner affirms that the following statements of fact are accurate and submit the same as evidence that the Office Action (Notice of Non-Compliant Amendment) in the subject application mailed by the Patent and Trademark Office on June 30, 2008, was never received at the law firm of Scully, Scott, Murphy & Presser P.C. Accordingly, it is respectfully requested that the holding of abandonment communicated by the Notice of Abandonment dated March 26, 2009, be withdrawn.

In accordance with the evidentiary guidelines set out in MPEP § 711.03(c)(I)(A), the Petitioner affirms to the following statements of fact:

1. Upon receipt of the Notice of Abandonment, I carefully reviewed the docket containing the application and determined that the Office Action of June 30, 2008 was not in the file. I had the Docketing Department search our complete data base, and it was determined that there was no record of the aforesaid Office Action therein.

2. For several years Scully Scott Murphy and Presser PC ("the Firm") has successfully relied upon the patent docketing software referred to as CPI (Computer Packages Inc., Patent Management System). It is widely used by patent law firms and patent departments around the world and is considered an excellent, i.e., very reliable, docketing software product.

3. The Firm's experience with CPI has been very positive because the software has reliably maintained the schedules of tasks and corresponding due dates for many thousands of patent applications and post-issuance patent records. The Petitioner believes that had the Office Action of June 30, 2008 been received at the Firm's address of record it would have been docketed in the CPI patent management database. **Exhibit A** provides a copy of the current CPI record for the above-referenced application. At the top of page 1 of **Exhibit A** the CPI record of the subject application is identified as the Country Application data, which comprises patent-related and administrative information such as the application number, attorney docket number, attorney of record and docket information. On page 2 of **Exhibit A** is the List of Actions and corresponding due dates that follows the course of prosecution of the subject application. The list identifies tasks that arose during prosecution of the subject application in the Patent and Trademark Office and the corresponding due dates, as well as the due dates for non-PTO task, e.g., transmittal of a client correspondence.

4. When a piece of correspondence comes in from the Patent Office data is entered in the CPI system, identifying the document and placing thereon the due date of the action to be taken in response to the communication.

5. The Petitioner respectfully directs attention to the "List of Actions" on the second page of **Exhibit A** wherein there is no task docketed for July 30, 2008, which is the expiration date of the Shortened Statutory Period for Reply (1 Month) for the Office Action dated June 30, 2008 (See Exhibit B), with respect to the above-identified application. As can be seen in the list, one of the last due dates prior to the current petition to revive regarding the subject application that was docketed for communication to the Patent and Trademark Office was a petition to revive with a due date of June 9, 2007. The Response was filed on May 18, 2007. Independent

confirmation of this filing can be found in **Exhibit C**, which is the list of Available Documents in the application's prosecution history that was downloaded from the PAIR system. The last communication from the firm is recorded on May 18, 2007, thereby confirming the accuracy of the records presented above. This docketing system is quite reliable.

The Petitioner further affirms that a search of the relevant file jackets, folders and records in the Firm's possession has not yielded the Office Action mailed on June 30, 2008.

Exhibits A-C support the conclusion that the Applicants' failure to file a timely response resulted from the Firm not receiving the Office Action of June 30, 2008 at the Firm's correspondence address of record.

6. It is respectfully noted that the Patent and Trademark Office guidelines explicitly assert that the Firm's master docket for the due date in question is required documentary proof of nonreceipt of the Office Action. See MPEP 711.03(c)(I)(A). In compliance with this requirement we submit **Exhibit D**, which is a redacted copy of the Firm's master docket for the due date of July 30, 2008, which is further evidence of the non-receipt of the Office Action allegedly mailed on June 30, 2008. It is redacted, as described below.

Exhibit D consists of nineteen sheets, the first eighteen of which provides a concise listing of the records for each patent-related task docketed with respect to actions to be taken for the entire Firm on that day related to filed applications. Items not related to prosecution in the USPTO have been removed. Further, non-relevant information, such as the names of the assignee and the attorneys assigned to the application have been removed. In addition, non-relevant information has also been removed from the items listed. The last page of **Exhibit D** provides a copy of the nonselective and unbiased search criterion entered into CPI in order to retrieve the relevant records for July 30, 2008 related to actions to be taken and the USPTO,

which make up the master docket for the day. Therefore, the Petitioner believes that **Exhibit D** reflects all patent-related tasks entered into the Firm's docket for July 30, 2008 with respect to U.S. prosecution. Most important is that **Exhibit D** does not include any task scheduled for the subject application.

The Petitioner respectfully submits that **Exhibit D** unambiguously establishes that the Firm had no record of responding to an Office Action relating to the subject application on July 30, 2008. Further, the Petitioner asserts in good faith that the reason that applicants did not respond to the Final Action is that it was never received by the Firm, thereby eliminating even the possibility of a timely response.

7. The Petitioner affirms that the foregoing Exhibits and remarks are, to the best of his knowledge, accurate and truthful. Accordingly, the Petitioner respectfully requests that the Commissioner grant the instant petition to withdraw the holding of abandonment in the above-

referenced application and to reissue the Office Action that was originally mailed on June 30, 2008, thereby re-opening prosecution of the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Steven Fischman", with a long horizontal flourish extending to the right.

Steven Fischman

Registration No. 34,594

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